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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

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Inventor(s): Ronald P. Dean et al

Confirmation No.: 6453

Application No.: 10/655,443

Examiner: A. J. Wujciak

Filing Date: 09/04/2003

Group Art Unit: 3632

Title: SYSTEM AND MEANS FOR THE SECURE MOUNTING OF A DEVICE BRACKET

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on May 20, 2005.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

() (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

- | | |
|------------------|-----------|
| () one month | \$120.00 |
| () two months | \$450.00 |
| () three months | \$1020.00 |
| () four months | \$1590.00 |

() The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account **08-2025** the sum of **\$500.00**. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

Ronald P. Dean et al

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PATENT APPLICATION
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

JUL 20 2005

In re Patent Application of:
Ronald P. Dean et al.

Application No.: 10/655,443

Confirmation No.: 6453

Filed: September 4, 2003

Art Unit: 3632

For: **SYSTEM AND MEANS FOR THE SECURE
MOUNTING OF A DEVICE BRACKET**

Examiner: A. J. Wujciak

APPEAL BRIEF

MS Appeal Brief - Patents
Director for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

As required under 37 C.F.R. § 41.37(a), this brief is filed within two months of the Notice of Appeal filed in this case on May 20, 2005, and is in furtherance of said Notice of Appeal.

The fees required under 37 C.F.R. § 41.20(b)(2) are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1206:

- I. Real Party In Interest
- II. Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Claimed Subject Matter
- VI. Grounds of Rejection to be Reviewed on Appeal
- VII. Argument
- VIII. Claims
- IX. Evidence
- X. Related Proceedings
- Appendix A Claims

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I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

Hewlett-Packard Development Company, L.P., a Texas Limited Partnership having its principle place of business in Houston, Texas.

II. RELATED APPEALS, INTERFERENCES, AND JUDICIAL PROCEEDINGS

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 20 claims pending in application.

B. Current Status of Claims

1. Claims canceled: None
2. Claims withdrawn from consideration but not canceled: 0
3. Claims pending: 1-20
4. Claims allowed: None
5. Claims rejected: 1-20

C. Claims On Appeal

The claims on appeal are claims 1-20

IV. STATUS OF AMENDMENTS

Appellant did not file an Amendment after the Final Office Action mailed March 23, 2005 (hereinafter the "Final Action"). As such, the claims are pending as submitted in the Response to the Office Action mailed September 29, 2004.

V. SUMMARY OF CLAIMED SUBJECT MATTER

According to claim 1, the bracket system comprises a plurality of chassis brackets (paragraph [0021], [0023]; figure 2, 203) attached to a chassis base (paragraph [0022], [0023]; figure 2, 201), a mounting bracket assembly (paragraph [0020]; figure 1, 100) with a plurality of tapered mounting bracket assembly slots (paragraph [0020], [0028]; figure 1, 101), and a plurality of tabs (paragraph [0022], [0028]; figure 2, 202) on said chassis base for engaging with said plurality of tapered mounting bracket assembly slots.

According to claim 9, the bracket system has at least one of said chassis brackets supporting two devices (paragraph [0024]; figures 3C and 4C).

According to claim 12, the bracket system for securing a subassembly to a chassis comprises a means for vertical alignment (paragraph [0020]) of the subassembly where said vertical alignment means also provides means for positive stop for said subassembly (paragraph [0020], [0029]), a means for horizontal alignment (paragraph [0010], paragraph [0028]) of said subassembly where said horizontal alignment means also provides means for positive stop for said subassembly (paragraph [0028]), and a means for securing said subassembly to said chassis where said means for securing includes a rotatable handle means (paragraph [0031]; figures 4A and 4B, 103).

According to claim 15, the device mounting system comprises a chassis base (paragraph [0022], [0023]; figure 2, 201) including a plurality of slotted brackets (paragraph [0021], [0023]; figure 2, 203), a mounting assembly (paragraph [0020]; figure 1, 100) having a plurality of horizontally-configured pegs extending from said mounting assembly (paragraph [0020], [0021], [0033]; figure 1, 102), wherein said plurality of horizontally-configured pegs engage with said slotted brackets to provide a positive stop for said mounting assembly (paragraph [0031], [0033]).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether claims 1-11 and 15-20 properly stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of United States Patent Number 6,616,106.

B. Whether claims 1, 3-4, 6, 8, 10, 15 and 19-20 properly stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,564,804 to Gonzalez et al. (hereinafter “Gonzalez”) in view of U.S. Patent No. 5,940,265 to Ho (hereinafter “Ho”).

C. Whether claim 9 properly stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gonzalez in view of Ho and further in view of U.S. Patent No. 5,828,547 to Francovich et al. (hereinafter, “Francovich”).

D. Whether claims 12-14 properly stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,564,804 to Gonzalez in view of U.S. Patent No. 4,947,661 to Yoshida (hereinafter “Yoshida”).

VII. ARGUMENT

A. Rejection based on judicially created doctrine of obviousness-type double patenting

Claims 1-11 and 15-20 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of United States Patent Number 6,616,106. Appellant proposes filing a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) if the Appellee’s rejection properly stands after the outcome of the pending appeal.

Further Appellant notes that claims 2, 5, 7, 11, and 16-18 are only rejected on the basis of double patenting. Therefore, Appellant asserts that those claims are in condition for allowance, subject only to the nonstatutory double patenting rejection of record.

B. Claims 1, 3-4, 6, 8, 10, 15 and 19-20

Claims 1, 3-4, 6, 8, 10, 15 and 19-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gonzalez in view of Ho.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on [appellant's] disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Without conceding the second criteria, Appellant asserts that the rejection does not satisfy the first and third criteria.

i. Lack of motivation to combine the references

It is well established that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The Appellee sets forth the following statement for the motivation to combine Gonzalez with Ho:

Gonzalez teaches the mounting bracket assembly with slot and the chassis base with tab, but fails to teach the slot is tapered and the chassis base having plurality of tabs. Ho teaches the slot (16) is tapered and plurality of tabs (21,22). It would have been obvious for one of ordinary skill in the art at the time the invention was made to have modified Gonzalez's slot with tapered (sic) and added plurality of tabs to chassis base as taught by Ho to provide convenience for accessing the tabs into the tapered slots.

Appellant respectfully disagrees with the Appellee's statement and asserts that the Appellee's reasoning is circular. Again, references may not be combined merely because they *can* be combined, and the Appellee may not use the Appellant's disclosure to find the motivation to combine references. *In re Vaeck*, 947 F.2d at 488. The Appellant respectfully

asserts that there is no motivation in Gonzalez to taper the slot(s) or provide a plurality of tabs as the Appellee claims.

Gonzalez describes holes 222 that provide openings for screws, or the like, to secure the disk drive to the bracket 108. Referring to figure 2, Gonzalez shows an example of hole 222 which is shown with a taper. Therefore, Gonzalez was well aware of tapered slots, and specifically chose not to taper base opening 216 (equated by the Appellee to the slot of claim 1) which mates with housing tab 402. Further, the Appellee seems to state that using a plurality of slots and tabs in the structure of Gonzalez would be desirable to “provide convenience for accessing” the tabs into the slots. The Appellee has provided no indication as to how adding more slots and tabs to Gonzalez would “provide convenience for accessing” as set forth in the Final Action.

Gonzalez shows the use of tapered tabs, yet explicitly chose not to taper the tab cited by the Appellee as corresponding to the structure in claim 1. Also, the Appellee has provided no indication as to how providing a plurality of tabs and slots would “provide convenience for accessing.” Therefore, the Appellant respectfully asserts that there is no motivation to combine Gonzalez and Ho. The combination put forth by the Appellee does not comport with the requirements of M.P.E.P. §2143.01, and as such, is improper. The Appellant respectfully asserts that the rejection of claims 1, 3-4, 6, 8-10, 15 and 19-20 based on this combination should be withdrawn.

ii. Failure to teach or suggest all claim limitations

Claim 1 requires a mounting bracket assembly with a plurality of tapered mounting bracket assembly slots...and a plurality of tabs on said chassis base. The Appellee acknowledges that Gonzalez does not show tapered mounting bracket assembly slots or a plurality of tabs on a chassis base, and relies upon Ho as teaching these elements. (Final Action, pg. 4). Appellant respectfully disagrees with the Appellee’s assertions and characterizations. Ho describes hook holes 16 and retaining notches 17 (at col. 2, lines 1-8), but only shows one of each in Figure 1, or shows differently shaped notches, if the corresponding element on the right side of diskette holder 1 is considered a notch. Therefore, Ho shows only a single tapered hook hole 16, and not a plurality of tapered mounting bracket

assembly slots as required. Therefore, Ho only shows a single tapered slot, and cannot be relied upon as describing a plurality of tapered mounting bracket slots as asserted by the Appellee.

Additionally, if another hook hole is implied on the other side of diskette holder 1, the shape of that hook hole cannot be determined, as is indicated by the shape of retaining notches 17 being inconsistent. Therefore, even if Ho is said to describe multiple hook holes, Ho only shows a single tapered hook hole, and cannot be relied upon as describing a plurality of tapered mounting bracket slots as asserted by the Appellee.

As Ho cannot be relied upon as showing these limitation, the combination of Ho and Gonzalez does not teach or suggest all of the claim limitations as required under 35 U.S.C. §103(a). Appellant therefore, asserts that claim 1 is patentable over the rejection of record for at least the reasons set forth above.

Claims 3-4, 6, 8, and 10 depend directly from base claim 1, and thus inherit all limitations of claim 1. Each of the claims 3-4, 6, 8, and 10 therefore set forth features and limitations not taught or suggested by the combination of Gonzalez in view of Ho. Thus, Appellant respectfully asserts that for at least the reasons set forth above, claims 3-4, 6, 8, and 10 are patentable over their respective 35 U.S.C. § 103(a) rejections of record.

C. Claim 9

Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Gonzalez in view of Ho and further in view of Francovich. Claim 9 depends from claim 1 and thus inherits all limitations of claim 1. As such, the Appellant reiterates the arguments set forth above, and contends that claim 9 is patentable for at least the reasons set forth with respect to claim 1. That is, the combination of Gonzalez and Ho fails to teach or suggest all limitations of claim 1 (and Francovich is not relied upon to teach or suggest the absent limitations). Moreover, the Appellant has demonstrated that there is no motivation to combine at least Gonzalez and Ho.

Moreover, claim 9 sets forth additional limitations that make it patentable over the proposed combination. Claim 9 requires “at least one of said chassis brackets supports two devices.” The Appellee states “Gonzalez fails to teach the chassis brackets supports two

devices. Franchovich et al. teach the chassis bracket (figure 10) supporting two devices (figure 11, 92 and 93).” (Final Action, pg. 5). However, the Appellant respectfully asserts the proposed combination fails to teach or suggest this claimed limitation. Rather, Franchovich discloses, in figure 11, control panel 93 in adjacent arrangement with drive 92. However, further reference to figure 11 makes clear that only drive 92 (and not panel 93) is supported by housing 86. Franchovich further discloses “bracket 90 facilitates insertion of drive 92 into housing 86...once drive 92 is captured by bracket 90 the assembly is inserted into housing 86.” (see Franchovich col. 6, lines 45-47, 51-53). Bracket 90 is absent between panel 93 and housing 86. As such, Franchovich only teaches a housing supporting *one* device (drive 92), but fails to disclose a chassis bracket supporting *two* devices.

D. Claims 12-14

Claims 12-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gonzalez in view of U.S. Patent No. 4,947,661 to Yoshida. To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on [appellant’s] disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Without conceding the second criteria, Appellant asserts that the rejection does not satisfy the first and third criteria.

i. Lack of motivation to combine the references

It is well established that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). In the Final Action, the Appellee states that it would have been obvious to combine the teachings of Gonzalez with the teachings of Yoshida so as to provide convenience for

releasing the subassembly from the chassis. (Final Action pg. 6). Appellant respectfully asserts that there is no motivation in Gonzalez to include the handle mechanism of Yoshida.

As cited by the Appellee, Gonzalez includes a means for locking bracket 108 into housing base 102 utilizing engaging tab 304 in housing opening 404. However, handle 1 and catch lever 3 of Yoshida are also a means for locking the bracket of Yoshida into a base assembly. Clearly, it would be redundant to combine the handle of Yoshida with the assembly of Gonzalez. Further, attaching the handle/lever of Yoshida to the assembly of Gonzalez would interfere with the operation of the locking mechanism as shown in Gonzalez. As such, the interference with the locking mechanism of Gonzalez would render Gonzalez unsatisfactory for its intended purpose. Appellant respectfully asserts that there is no motivation to combine the handle/lever of Yoshida with the assembly of Gonzalez as the handle/lever of Yoshida would be redundant and would render Gonzalez unsatisfactory for its intended purpose. *See In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The combination put forth by the Appellee, therefore, does not comport with the requirements of M.P.E.P. § 2143.01 and is, therefore, improper. Therefore, the rejection of claims 12-14 should be withdrawn.

ii. Failure to teach or suggest all claim limitations

Claim 12 requires a means for vertical alignment. The Appellee, in the Final Action, opines that element 214 of Gonzalez is a means for vertical alignment. (Final Action, pg. 5). Further, the Appellee does not rely upon Yoshida as teaching or suggesting this feature. The Appellant respectfully asserts that Gonzalez alone, and in combination with Yoshida, does not teach or suggest a means for vertical alignment. As described in Gonzalez, element 214 is a base tab designed so that the second bracket can slidably enter an opening 220 of the first bracket 108, and allow stacking of the brackets. (*see* Gonzalez col. 3, lines 21-28 and 38-54). Gonzalez fails to disclose or suggest base tab 214 as fitting securely against, or providing any restraint to, bracket 108. This is in contrast to Gonzalez' explicit teaching of base opening 216, which is described as fitting securely with housing tab 402, thereby preventing bracket 108 from moving in a first degree of freedom relative to computer housing 100. (Gonzalez col. 3, lines 30-34). Clearly, Gonzalez intended for base opening 216 to provide a mechanism for alignment. As such, Gonzalez provided sufficient structure for, and explicitly disclosed, base opening 216 as a mechanism for alignment. Gonzalez did neither with

respect to base tab 214. If base tab 214 was intended to be a mechanism for alignment, it would have been described as such by Gonzalez. Such alignment is not inherent in the structure of base tab 214 as its use as an alignment means would be dependent on the relative tolerances involved. This, of course, is not shown in the figures or described by the specification. Therefore, base tab 214 is not a means for vertical alignment as set forth in claim 12. As the combination of Gonzalez and Yoshida do not show all the claim limitations set forth in claim 12, Appellant respectfully asserts that claim 12 is allowable over the rejection of record.

Claims 13-14 depend from claim 12, and thus inherit all limitations of claim 12. Each of claims 13-14 set forth features and limitations not recited by the combination of Gonzalez and Yoshida. Thus, Appellant respectfully asserts that for at least the above reasons, claims 13-14 are patentable over the 35 U.S.C. § 103(a) rejection of record.

VIII. CLAIMS

A copy of the claims involved in the present appeal is attached hereto as Appendix A. As indicated above, the claims in Appendix A do include the amendments filed by Appellant on March 23, 2005.

IX. EVIDENCE

No evidence pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the Appellee is being submitted.

X. RELATED PROCEEDINGS

No related proceedings are referenced in II. above, or copies of decisions in related proceedings are not provided, hence no Appendix is included.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Label No. EV482708783US in an envelope addressed to: MS Appeal Brief - Patents, Commissioner for Patents, Alexandria, VA 22313.

Date of Deposit: July 20, 2005

Typed Name: Elise Perkins

Signature: Elise Perkins

Respectfully submitted,
By: _____
Michael A. Papalas
Attorney/Agent for Appellant(s)
Reg. No. 40,381
Date: July 20, 2005
Telephone No. (214) 855-8186

APPENDIX A

Claims Involved in the Appeal of Application Serial No. 10/655,443

1. A bracket system comprising:
a plurality of chassis brackets attached to a chassis base;
a mounting bracket assembly with a plurality of tapered mounting bracket assembly slots; and
a plurality of tabs on said chassis base, said plurality of tabs for engaging with said plurality of tapered mounting bracket assembly slots.
2. The bracket system of claim 1 wherein the mounting bracket assembly further comprises a handle engageable with rotation pegs on the chassis bracket.
3. The bracket system of claim 1 wherein said chassis brackets further comprise slots, and said mounting bracket assembly further includes a plurality of horizontally protruding pegs, and wherein engagement of said chassis bracket slots and said mounting bracket pegs provide a positive stop for said mounting bracket assembly.
4. The bracket system of claim 1 wherein engagement of said tabs and said mounting bracket assembly slots provide a positive stop for said mounting bracket assembly.
5. The bracket system of claim 3 wherein said chassis brackets are positioned laterally to said mounting bracket assembly so that said mounting bracket pegs frictionally engage said chassis bracket slots when a mounting bracket handle frictionally engages rotation pegs on said chassis bracket.
6. The bracket system of claim 1 wherein said mounting bracket assembly slots frictionally engage said tabs.
7. The bracket system of claim 1 wherein said chassis brackets are attached to said chassis base with rivets.

8. The bracket system of claim 1 wherein said mounting bracket pegs are offset.

9. The bracket system of claim 1 wherein at least one of said chassis brackets supports two devices.

10. The bracket system of claim 1 wherein said mounting bracket assembly will frictionally engage said chassis bracket without a device present.

11. The bracket system of claim 5 wherein said mounting bracket assembly can be moved when said mounting bracket handle is not engaged with said chassis bracket rotation pegs, said mounting bracket assembly movement allowing said mounting bracket to be aligned.

12. A bracket system for securing a subassembly to a chassis comprising:
means for vertical alignment of the subassembly, said vertical alignment means also providing means for positive stop for said subassembly;
means for horizontal alignment of said subassembly, said horizontal alignment means also providing means for positive stop for said subassembly; and
means for securing said subassembly to said chassis, said means for securing including a rotatable handle means.

13. The means of claim 12, said securing means further comprising a means for locking said subassembly to said chassis.

14. The means of claim 12, said securing means also providing means for positive stop for subassembly.

15. A device mounting system comprising:
a chassis base including a plurality of slotted brackets;
a mounting assembly having a plurality of horizontally-configured pegs extending from said mounting assembly; and
wherein said plurality of horizontally-configured pegs engage with said slotted brackets to provide a positive stop for said mounting assembly.

16. The device mounting system of claim 15 further comprising a handle on said mounting assembly, said handle comprising slots operable to engage rotation pegs on said slotted brackets.

17. The device mounting system of claim 16 wherein rotating said handle locks said mounting assembly in said chassis base.

18. The device mounting system of claim 16 wherein rotating said handle when said handle is engaged with said rotation pegs causes said mounting bracket assembly to move back in said chassis base.

19. The device mounting system of claim 15 wherein said mounting assembly further comprises a plurality of narrowing slots, and said chassis base further comprises a plurality of tabs, such that said tabs are operable to engage said narrowing slots on said mounting assembly.

20. The device mounting system of claim 19 wherein said plurality of tabs on said chassis base and said plurality of narrowing slots on said mounting assembly provide a positive stop for said mounting bracket assembly when engaged.

APPENDIX B

Evidence

None

APPENDIX C

Related Proceedings

None